

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN D. BURCH and JOHN C. FAGLEY

MAILED

MAY 30 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1216
Application No. 10/623,674

ON BRIEF

Before PAK, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we determine that the above-identified application is not ready for a decision on appeal under 35 U.S.C. § 134. Accordingly, we remand this application to the examiner for further consideration and action not inconsistent with our opinion below. 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

In the answer mailed September 07, 2005, the Examiner lists two publications in item No. 8 as comprising the evidence being

relied upon in rejecting appellants' appealed claims. In item No. 9 of that answer, the examiner states:

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12, 15-18, 20-22 and 24-30 are rejected under 35 U.S.C. § 103(a). This rejection is fully set forth in prior Office action, Paper No. 22005.

Unfortunately, the examiner has referred to such a prior office action in the answer for the statements of rejection "without fully restating the point relied on in the answer," as is required. See the first full sentence on page 1200-28 of Section 1207.02 of the Manual of Patent Examination Procedure (MPEP), 8th ed., Rev. 3, Aug. 2004. Furthermore, the statement of rejection is clearly inadequate in that the final or non-final office actions associated with this application do not bear such a paper number. Paper No. 22005 that the examiner refers to in the answer cannot be definitively matched with any of these prior office actions.

Even were we to speculate that Paper No. 22005 referred to in the answer is the final office action, there are other inconsistencies in the rejections set forth in the final office action that would still require resolution before we could render a decision.

In this regard, a review of the final rejection mailed February 09, 2005 reveals fifteen separate rejections under 35 U.S.C. § 103(a). The examiner relies on Grasso et al. (U.S. Patent Application Publication No. US2001/0004500), Bloomfield (U.S. Patent No. 3,982,962) and Mugerwa in a rejection of independent claim 1 in the final rejection. However, dependent claim 4, for example, is rejected over Grasso et al and Bloomfield et al as applied to claim 1 further in view of Beshty et al. (U.S. Patent No. 6,375,924) without a reference to Mugerwa as also used in the examiner's rejection of claim 1.

It is not clear whether the examiner inadvertently omitted Mugerwa in the statement of the rejection of claim 4 (dependent claim 4 includes all of the limitations of claim 1), or the examiner has another basis for the rejection of claim 4 that does not require reliance on Mugerwa. A similar question exists with respect to the examiner's rejections of dependent claims 5, 10, 11, 12, 15, 16, 17, 18 regarding the examiner's intent to rely on Mugerwa or, in the alternative, the existence of an alternative basis for rejecting those dependent claims without Mugerwa.¹

¹ As another matter, we note the discrepancy in the examiner's list of two references being relied upon in rejecting the claims at numbered item 8 of the answer and the much larger number of references applied in the rejections set

Concerning this matter, the examiner must clarify which prior art evidence is being relied upon in the above-noted rejections of the dependent claims in question that may be maintained by the examiner after consideration of this Remand. If the examiner intends to rely on Mugerwa in rejecting the above-noted dependent claims, which claims include all of the limitations of claim 1, the examiner must include Mugerwa in the statements of rejection being maintained.²

On the other hand, if the examiner did not intend to rely on Mugerwa in rejecting dependent claims 4, 5, 10, 11, 12, 15, 16, 17, 18, the examiner must clearly explain why Mugerwa, which is necessary for the rejection of independent claim 1, is not necessary in rejecting those above-noted dependent claims, each of which includes all of the limitations of claim 1, in responding to this Remand. This is particularly significant in that the examiner has not explained how Grasso and Bloomfield taken without Mugerwa but with the other references applied against those dependent claims would have suggested a claimed air

forth in the final office action.

² We leave it to the examiner to determine whether responding to this Remand may require reopening prosecution or can be accomplished by way of the submission of a supplemental answer.

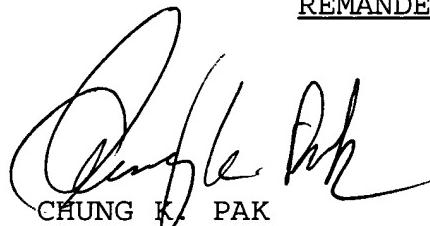
recycle limitation included in those dependent claims by virtue of their dependency on claim 1.

Upon receipt of this application as a result of this Remand, the examiner should take appropriate action to resolve the above noted inconsistencies. Any supplemental answer that may be submitted in responding to this Remand must include a full presentation of the rejections being maintained by the examiner, and reasons therefore. A complete listing of the references being relied upon by the examiner in maintaining the rejections must also be supplied. In this regard, any supplemental answer that may be prepared by the examiner in response to this Remand should, in essence, be in the format of a complete substitute examiner's answer that is in compliance with current office policy. This would avoid introducing additional anomalies that would likely result from continued reliance on the previously submitted incomplete answer.

This Remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this Remand by the Board.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (8th ed., Rev. 3, Aug. 2005). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED


CHUNG K. PAK)
Administrative Patent Judge)


PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES


JEFFREY T. SMITH)
Administrative Patent Judge)

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